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09/936,953	09/17/2001	Junzo Sunamoto	Yanagihara Case 62	4435
7590	03/01/2006		EXAMINER	
Flynn Thiel Boutell & Tanis 2026 Rambling Road Kalamazoo, MI 49008-1699			CHONG, YONG SOO	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/936,953

Filing Date: September 17, 2001

Appellant(s): SUNAMOTO ET AL.

Terryence F. Chapman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/30/2006 appealing from the Office action mailed 5/4/2005.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 8/3/2005 has not been entered.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Sunamoto et al. (English Translation of JP 03-292301)

Ishiwatari et al. (US Patent 6,074,652)

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-5, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunamoto et al. (English Translation of JP 03-292301) in view of Ishiwatari et al. (US Patent No. 6,074,652).

Sunamoto et al. disclose polysaccharide-sterol derivatives. Exemplified is an emulsion comprising 10 mg oil (glycerol tricaprylate, a cosmetic component), 5 mg pullulan-cholesterol derivative, and 1 mL water (a cosmetic component), a percent weight of 0.5% pullulan cholesterol derivative and 95.5% cosmetic components (oil and water), see page 14. For the pullulan-cholesterol derivative having the structure of formula (1) of the instant claims, see page 2, claim 1. For 0.1 - 6 units per 100 monosaccharide units, see page 2, claim 1.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended uses of claims 8 and 9 are not afforded patentable weight.

It is further respectfully pointed out that the recitation "cosmetic" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Sunamoto et al. does not teach a solvent containing at least one of a volatile oil and a volatile solvent or wherein said cosmetic components additionally comprise at least one member selected from moisture-preserving agents, UV absorbers, beauty whitening agents, inorganic pigments etc... or wherein the solvent comprises a volatile hydrocarbon oil having a boiling point at normal pressure in the range from 60-160 °C.

Ishiwatari et al. teach, in col. 1 line 40 to col. 2 line 45, an oil-in-water emulsified composition which has good usability and stability comprising an α-monoalkyl glyceryl ether, a wax, and a silicone oil, and can contain a higher alcohol, a water-soluble high polymer, an humectant, and a UV-protecting agent and film forming agent.

Ishiwatari et al. teach, in col. 5 lines 5-10, the preferred silicone oils can be volatile or non-volatile, straight chain or cyclic, and with specific embodiments being dimethylpolysiloxane, decamethylcyclopentasiloxane, and methylphenylpolysiloxane.

Ishiwatari et al. teach, in col. 10 lines 55-67, that the oil-in-water emulsified composition can be stabilized by addition of water-soluble high polymers such as polysaccharides.

Ishiwatari et al. teach, in col. 11 lines 15-35, that the oil-in-water emulsified compositions are to be used in the formulation of cosmetic products. In example 1-1 a cosmetic cream formulation is presented comprising a water phase and an oil phase. In the oil phase octamethylcyclotetrasiloxane (30% by weight) and dimethylpolysiloxane (3% by weight) are present. The examiner notes that both of these siloxanes meet the applicant's examples of a volatile solvent and a volatile oil having a boiling point between 60-160 °C. Additionally the water phase contain the humectants malitol and glycerin (moisture-preserving agents).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pullulan-sterol compositions of Sunamoto et al. in the cosmetic water-in-oil emulsions of Ishiwatari et al. as pullulan-sterol compositions had previously been used in the formulation of emulsions (and liposomes) and that the pullulan-sterol emulsions exhibited improved chemical and physical stabilities. One would have been motivated to use the pullulan-sterol compounds in the Ishiwatari et al cosmetic emulsions in order to take advantage of the improved chemical and physical stability exhibited by the pullulan-sterol compounds.

(10) Response to Argument

Appellants argue that Sunamoto et al. does not disclose the presence of a solvent containing at least one of the volatile oil and a volatile organic solvent or the use of the polysaccharide-sterol derivatives in a cosmetic composition. Essentially, appellants argue that Sunamoto et al. and Ishiwatari et al. contain no motivation that would suggest to one of ordinary skill in the art to combine these references.

Examiner respectfully argues there is ample motivation to combine these references as admitted by the appellants when they concur to Sunamoto's disclosure that polysaccharide-sterol derivatives as having improved chemical and physical stabilities. Sunamoto et al. clearly disclose the use of pullulan as the polysaccharide in the polysaccharide-sterol component of emulsion compositions. Ishiwatari et al. also disclose the use of volatile or non-volatile water-soluble high polymers, for example polysaccharides, in emulsion compositions.

Therefore, one would have been motivated to use the pullulan-sterol compounds in the Ishiwatari et al. cosmetic emulsions in order to take advantage of the improved chemical and physical stability exhibited by the pullulan-sterol compounds.

Examiner respectfully points out that the recitation "cosmetic" is not afforded any patentable weight because the recitation occurs in the preamble and the claims are directed to a composition.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish from each other. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of a composition claim will be given no patentable weight.

It is further respectfully pointed out that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). See MPEP 2111.02.

Finally, appellants argue, "the cosmetic product of the present invention has unexpectedly improved properties with respect to insusceptibility to transcription of an applied layer or coating thereof onto surfaces contacted therewith." Appellants argue against the composition of Ishiwatari et al. only, specifically arguing that polysaccharide-sterol derivatives are not disclosed. Examiner notes that the Ishiwatari et al. reference was used in conjunction with the Sunamoto et al. reference, which states the use of polysaccharide-sterol derivatives. Furthermore, Ishiwatari et al. state the use of water-soluble high polymers such as polysaccharides for stabilization of the composition. This allows for the two-way motivational use of polysaccharide-sterol derivatives in the compositions disclosed by Sunamoto and Ishiwatari et al. for stabilization purposes.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Yong S. Chong, Ph.D.
Patent Examiner
Art Unit 1617



SREENI PADMANABHAN
SUPERVISOR, PATENT EXAMINER

ysc
February 11, 2006

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